

REMARKS/ARGUMENTS

Claims 1-24 remain in the application, all of which stand rejected.

1. Rejection of Claims 1-20, 23 and 24 Under 35 USC 101

Claims 1-20, 23 and 24 stand rejected under 35 USC 101 as being drawn to non-statutory subject matter.

With respect to claims 1-20 and 24, the Examiner asserts that these claims are non-statutory because the phrase "computer readable medium" reads on propagation or transport mediums (or carrier waves). In response, applicants have amended these claims to recite that the "computer readable medium" is a "non-transitory computer readable medium". Such an amendment was suggested in Under Secretary Kappos' memo dated January 26, 2010, titled "Subject Matter Eligibility of Computer Readable Media". This amendment is not believed to introduce new matter; and as indicated in Under Secretary Kappos' memo, such an amendment would normally not introduce new matter.

With respect to claim 23, the Examiner asserts that this claim is non-statutory because "it is not clear that the features are anything other than someone sitting at a terminal." See, 12/17/2009 Office Action, p. 2. In response, applicants have amended claim 23 to include recitations found in other pending claims, which recitations make it clear that the method is being executed by a computer.

At least as amended, claims 1-20, 23 and 24 are believed to be directed to statutory subject matter, and it is requested that all rejections under 35 USC 101 be withdrawn.

2. Rejection of Claims 1-24 Under Double Patenting

Claims 1-24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 in view of claim 21 of U.S. Patent No. 7,039,545.

Claims 21-22 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 in view of claim 19 of U.S. Patent No. 7,039,545.

Claim 23 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 in view of claim 20 of U.S. Patent No. 7,039,545.

Claim 24 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 in view of claim 21 of U.S. Patent No. 7,039,545.

Without commenting on the propriety of the above double patenting rejections, and to advance prosecution, applicants submit herewith an appropriate Terminal Disclaimer.

3. Rejection of Claim 24 Under 35 USC 103(a)

Claim 24 stands rejected under 35 USC 103(a) as being unpatentable over Gray et al. as applied to claim 1 of the previous action, and further in view of Hamameh et al. In particular, the Examiner asserts that:

... The applicant argues that his system is allowable over the references cited because the references do not teach the evaluating feature of his claims; however, no such feature exists in claim 24 and therefore, the previous rejection remains.

12/17/2009 Office Action, p. 4.

However, applicants' claim 24 recites, in part:

program code to evaluate whether any of the respective first and second subtest code portions of the respective first and second pre-established test programs may be combined to create a new subtest code portion in a new test program, said program code to evaluate providing at least one output result thereof;

(Emphasis added)

As a result, applicants do not understand the basis for the Examiner's rejection, because an 'evaluating feature' is clearly recited in claim 24. Applicants respectfully ask the Examiner to reconsider his rejection and/or provide a more detailed explanation of what feature he believes is missing from claim 24.

4. Conclusion

In light of the amendments and remarks provided herein, applicants respectfully request the issuance of a Notice of Allowance.

Respectfully submitted,
HOLLAND & HART, LLP

By: Gregory W. Osterloth
Gregory W. Osterloth
Reg. No. 36,232
Tel: (303) 295-8205